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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,693	11/20/2003	Hai H. Trieu	4002-3430/PC775.01	9321
<div>7590 07/09/2008</div> <div>Woodard, Emhardt, Moriarty, McNett & Henry LLP</div> <div>Bank One Center/Tower</div> <div>Suite 3700</div> <div>111 Monument Circle</div> <div>Indianapolis, IN 46204-5137</div>				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
07/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,693

Applicant(s)

TRIEU, HAI H.

Examiner

Anu Ramana

Art Unit

3733

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-40, 42-49, 51, 52, 55-62, 64 and 65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-40, 42-49, 51, 52, 55-62, 64 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/20/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37, 42-47, 49, 51-52 and 55-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Sertich (US 5,800,550).

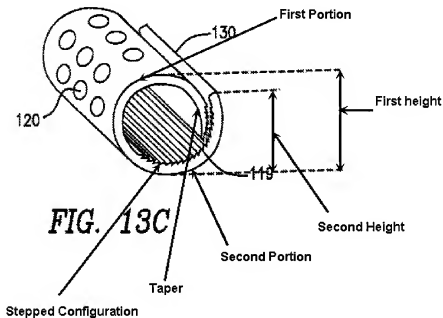
Sertich discloses a system for intervertebral disc repair including: a delivery instrument 98; an expandable element 112 at a distal end thereof; and an expandable device 32 removably mountable to the expandable element wherein the expandable device has a cavity 44 that can be packed with bone filler (Figs. 1A, 3 and 7B, cols. 5-9 and col. 10, lines 1-27).

Claims 37-40, 42-49, 51-52, 55-62, 64 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Beyar et al. (US 6,127,597).

Beyar et al. disclose a system for intervertebral disc repair including: a syringe or "delivery instrument"; an expandable element or balloon along a distal portion thereof; a spacer or "expandable device" 125 or 130 removably mounted on the expandable element or balloon; bone growth openings 120 provided in first and second portions of the expandable device; and spikes or "bone engagement members" 153 provided on the first and second portions wherein bone graft or filler is placed in lumen of the expandable device to promote fusion (Figs. 12-13C, col. 29, lines 31-67, col. 30 and col. 31, lines 1-4). It is noted that the first portion could be a portion along the top of the spacer while the second portion could be a portion along the bottom of the spacer.

Beyar et al. clearly disclose that a balloon is inserted through the syringe and inflated to dilate the spacer to the diameter of the intervertebral space (col. 30, lines 28-32).

Regarding claims 44-46, Beyar et al. disclose all elements of Applicant's claimed invention as illustrated in marked up Fig. 13C below.



Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on March 12, 2008 have been fully considered.

Regarding the rejections of claims 37, 42-47, 49, 51-52 and 55-62 under 35 USC 102(b) over Sertich, contrary to Applicants arguments, Sertich discloses all element of Applicants' invention as noted in marked up Fig. 1A from Sertich provided in the previous office action. As discussed in this office action, the Examiner is interpreting element 112 to be expandable in that its length within the implant changes as it is screwed into the implant. It is suggested that Applicants amend the claim to recite "a radially expandable element" to overcome this rejection. On page 8, Applicants argue

that "pegs 70" are designed to penetrate bone not compress it. It is noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding Applicant's concern about the propriety of the rejections over Beyar et al., the Examiner has further clarified the rejection in this action. Beyar et al. clearly anticipates Applicant's claimed invention since it explicitly or inherently discloses every limitation recited in the claims as elaborated in this office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

July 2, 2008

/Anu Ramana/

Primary Examiner, Art Unit 3733